

REMARKS/ARGUMENTS

Applicant has received the Office Action dated October 4, 2006, in which the Examiner: 1) rejected claims 21 and 23 under 35 U.S.C. § 103(a) as being unpatentable over *Swamy et al.* (U.S. Pat. No. 6,035,350, hereinafter "*Swamy*") in view of *Kirkendoll* (U.S. Pat. No. 5,826,042, hereinafter "*Kirkendoll*"); 2) rejected claims 22 and 24 as being unpatentable over *Swamy* in view of *Kirkendoll* and further in view of *Hatakeyama et al.* (U.S. Pat. No. 6,545,587, hereinafter "*Hatakeyama*"); and 3) allowed claims 1-16.

Applicant respectfully requests reconsideration and allowance of the pending claims.

I. U.S.C. § 103 REJECTIONS

The Examiner rejected claims 21 and 23 under 35 U.S.C. § 103(a) as being unpatentable over *Swamy* in view of *Kirkendoll*. Applicant respectfully disagrees with the Examiner's assertions because the Examiner has failed to establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art must teach or suggest "all the claim limitations" (MPEP 2143). "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With respect to claim 21, the prior art fails to teach or suggest all the claim limitations as is required. Specifically, the cited references fail to teach or suggest Applicant's claimed "I/O device [that] is inoperable when connected to the computer and is operable when removed from the computer and functions as a remote control for wirelessly communicating commands to the processor through the receiver system." The Examiner recognizes that *Swamy* fails to teach or suggest an "I/O device is inoperable when connected to the computer" but cites

Kirkendoll as teaching the limitation. *Kirkendoll* does not teach this limitation, but is instead directed to a docking station for a laptop.

Second, there is no motivation to combine *Swamy* and *Kirkendoll*. The Examiner suggests it would have been obvious to modify *Swamy*'s I/O device to be inoperable when connected to a portable computer based on *Kirkendoll*. Applicant disagrees for several reasons. First, *Kirkendoll* is directed to a docking station and a laptop rather than a laptop and a removable I/O device. Second, *Swamy*'s I/O device is intended to be functional when connected to a portable computer. Thus, *Swamy* teaches against the Examiner's proposed modification which would render *Swamy*'s portable computer unsatisfactory for its intended purpose(see MPEP 2143). For at least these reasons, claim 21 and its dependent claims are allowable over the cited references.

II. ALLOWED CLAIMS

Applicant acknowledges with appreciation the allowance of claims 1-16.

III. CONCLUSION


In the course of the foregoing discussions, Applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including

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fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,


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